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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08350.1367-01000

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Application Number

10/788,431

Filed

February 27, 2004

First Named Inventor

Scott A. Leman

Art Unit

3748

Examiner

Kyle M. Riddle

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 54,047

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

F. Chad Copler

Typed or printed name

571-203-2747

Telephone number

October 14, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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Customer No.: 22,852
Attorney Docket No. 08350.1367-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Scott A. LEMAN)	Group Art Unit: 3748
)	
Application No.: 10/788,431)	Examiner: Kyle M. RIDDLE
)	
Filed: February 27, 2004)	Confirmation No.: 7015
)	
For: ENGINE VALVE ACTUATOR)	Mail Stop AF
)	

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Final Office Action mailed June 14, 2005, and pursuant to the July 12, 2005, OG Notice regarding the Pre-Appeal Brief Conference Pilot Program, Applicant respectfully requests panel review of the final rejections under 35 U.S.C. § 103(a) discussed in the remarks below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal and a petition for a one-month extension of time.

REMARKS

I. Status of the Claims

Claims 1-40 remain pending in this application. Claims 12, 15-20, 22-24, 29, 32, 35, and 38 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,050,435 to Fuller, Jr. et al. ("Fuller"). Claims 12, 15-19, 22, 24, 29, 32, 35, and 38 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,423,709 to Arrieta.

II. Substantive Issues - Rejection of Claims under 35 U.S.C. § 103(a)

Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 12, 15-20, 22-24, 29, 32, 25 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Fuller at least for the reason that Fuller fails to teach or suggest all the claim limitations. See MPEP. § 706.02(j).

In the Office Action, the Examiner correctly recognizes that Fuller "fail[s] to disclose the locked open position as an intermediate position or holding the exhaust or intake valve open during at least a portion of an intake or compression stroke to allow exhaust gas to be reintroduced into the cylinder or reduce the compression ration of the engine," with respect to each of the rejected independent claims. Office Action at 3. In an effort to overcome this deficiency, the Examiner points to col. 2, lines 1-3 of the reference, as allegedly citing a "shortened pushrod for holding the valves in an open position." Office Action at 3. The Office Action further alleges that "a shortened position would inherently be in an intermediate position between completely open and closed." *Id.* To support an inherency argument, "[t]he evidence must make clear that the missing

feature is **necessarily** present, and that it would be so recognized by persons of skill in the relevant art.” *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1328 (Fed. Cir. 2001) (emphasis added). The inherency argument in the Office Action fails for at least two reasons. First, a shortened pushrod does not necessarily mean an intermediate position. If the pushrod is shortened enough, the pushrod will not be long enough to engage the rocker arm at all, and the associated valve will remain closed. Thus, a “shortened pushrod” would not “inherently be in an intermediate position,” as alleged in the Office Action. Second, even if a shortened position were inherent, Fuller fails to disclose holding the valve in an intermediate position as required by at least claim 12, as argued previously by the Applicant.

Additionally, a careful reading of Fuller, including the cited lines of text, reveals that the reference does not support the position alleged in the Office Action. The exact language of the relevant portion of cited text reads: “Control of fluid pressure supply to the device incorporating the invention enables the device to selectively function as a relatively solid extension of the pushrod for normal operation engine, as a shortened pushrod for the intake valves or as a fluid ram or jack for holding the exhaust valve open while the pushrod is still free to reciprocate.” Col. 1, line 65 - col. 2, line 3. While Fuller does disclose “a shortened pushrod for the intake valves” function, Fuller does not indicate that such a function includes holding a valve in an intermediate position. In fact, a closer look at the specification reveals that Fuller discloses only the deactivation of intake valves, while “the pushrod 26 simply reciprocates freely within the bottom chamber 56.” Col. 4, lines 4-6. Fuller further elaborates that in this function the “[r]ocker arm 18 will not therefore be acted upon by rod 26.” Col. 4, lines 6-7. This function is

consistent with "a shortened pushrod for the intake valves," such that the pushrod is too short to act upon the rocker arm. Therefore, the Fuller reference does not inherently disclose an intermediate position as alleged in the Office Action. Additionally, the Office Action has failed to address the "holding" function of at least claim 12, with any more than a conclusory statement that such a function exists. Such "broad conclusory statements standing alone are not 'evidence'." In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). The Office Action fails to establish a *prima facie* case of obviousness.

Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 12, 15-20, 22, 24, 29, 32, 25 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Arrieta at least for the reason that Arrieta fails to teach or suggest all the claim limitations. See MPEP. § 706.02(j).

As with Fuller above, the Office Action correctly recognizes that Arrieta "fail[s] to disclose the locked open position as an intermediate position or holding the exhaust or intake valve open during at least a portion of an intake or compression stroke to allow exhaust gas to be reintroduced into the cylinder or reduce the compression ratio of the engine," with respect to each of the rejected independent claims. Office Action at 4.

In an attempt to overcome the deficiency, the Office Action simply states, with no support, that "holding the valve open in an intermediate position would have been obvious depending on design variables such as desired timing and lift considerations, engine design, etc." Office Action at 4. Such "broad conclusory statements standing alone are not 'evidence'." In re Kotzab, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1317. Applicant has previously pointed out that Arrieta is simply not capable of an

intermediate position. This position has not been rebutted by the Examiner. The unsupported, conclusory allegations in the Office Action fail to support any *prima facie* case of obviousness.

III. Conclusion

Because the Examiner's 35 U.S.C. § 103(a) rejections over Fuller and Arrieta include factual deficiencies, Applicant is entitled to a pre-appeal brief review of the Final Office Action. Moreover, in view of the foregoing remarks reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 14, 2005

By: _____

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